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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR     | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|--------------------------|---------------------|------------------|
| 10/049,749      | 06/26/2002  | Michael Charles Sheppard | US57.0320-WO        | 5993             |

7590 07/25/2003

Schlumberger Doll Research  
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EXAMINER

FAYYAZ, NASHMIYA SAQIB

ART UNIT

PAPER NUMBER

2856

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                    |                 |
|------------------------------|--------------------|-----------------|
| <b>Office Action Summary</b> | Application No.    | Applicant(s)    |
|                              | 10/049,749         | SHEPPARD ET AL. |
|                              | Examiner           | Art Unit        |
|                              | Nashmiya S. Fayyaz | 2856            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 May 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-13 and 15-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-13 15-18 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ . 6) Other: \_\_\_\_\_ .

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1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

2. Claims 1-12 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, on line 2, "the surface" lacks antecedent basis. In claim 2, "the passive data receptor" lacks clear antecedent basis on lines 3 and 4. In claim 3, "the sensing apparatus" lacks antecedent basis. Claim 4 is not clear since it would appear that "the casing", "the electronic memory" and "the sealable aperture" lack clear antecedent basis since each receptor would have one of each. In claim 5, "the sealable aperture" and "the rigid casing" lack clear antecedent basis.

3. Claims 1-4, 9, 12, 13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Aronstam et al - U.S. Patent # 6,443,228.

As to claims 1-4, 9, 12, 13 and 15-17, Aronstam et al disclose a method and device employing flowable devices 63 in wellbores to communicate between surface and downhole instruments, the devices include memory devices and/or sensors for measurements where the fluid moves the device in the wellbore, see Figs. 1-4, notably Fig. 4 and column 4, lines 66 et seq.

As to claim 3, note Fig. 4 and column 8, lines 31-44 which describe a "container" and "selectively" releasing the devices 209.

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As to claim 4, see Fig. 6 and “ceramic” capsule material 452 as in column 9, lines 57 et seq.

As to claim 9, note ballast 470. As to claim 12, Aronstam et al teach that the flowable devices can be “programmed or coded” with desired information. As to claim 15, note sensors 42 within drilling assembly 30 for determining position during drilling. As to claims 16-17, note drilling assembly includes a mud motor section 32 and a power section 33 to rotate the drill bit 26 for descent.

4. Claims 5-8, 10-11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aronstam et al.

As to claims 5-8 and 10-11, Aronstam et al disclose the flowable device as in Fig. 6 but lack specifics of sealing material, or spherical shape with two hemispheres joined by plastics. Firstly, the shape is considered to have been an obvious design choice and using seals would have been obvious as well to one skill in the art at the time of the invention in order to prevent harsh fluids from entering the sensitive electronics. As to claims 10-11, the dimensions of devices are also considered to be obvious design choices to one of ordinary skill in the art at the time of invention without performing undue experimentation.

As to claim 18, usage of a wireline with a drill bit is old and well-known in the wellbore art. Therefore, inclusion of a wireline is considered a matter of obvious design choice in order to retrieve the drill bit subsequent to drilling.

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5. Applicant's arguments filed 5/6/03 have been fully considered but they are not persuasive. Applicant presented a declaration under 37 CFR 1.132 by William Wang to establish conception of the invention prior to the effective date of Aronstam. Such an argument is not found persuasive because a declaration under 37 CFR 1.132 cannot be used to establish date conception of an invention but rather a declaration under 37 CFR 1.131 should be used. Further, the declaration under 37 CFR 1.131 must be made by the inventor(s), unless otherwise indicated, see MPEP 715.04.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication should be directed to N. Fayyaz at telephone number 305-4891.

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Fayyaz/ek

07/17/03



Hezron Williams

SUPERVISORY PATENT EXAMINER

TECHNOLOGY CENTER 2800